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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

08/460,715 06/02/95 MACH

M 5552.0738-02

FINNEGAN HENDERSON FARABOW  
GARRETT AND DUNNER  
1300 I STREET NW  
WASHINGTON DC 20005-3315

HM21/0901

EXAMINER

LEE, D

|          |              |
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| ART UNIT | PAPER NUMBER |
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1643

DATE MAILED:

09/01/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

|                              |                                      |                                   |
|------------------------------|--------------------------------------|-----------------------------------|
| <b>Office Action Summary</b> | Application No.<br><b>08/460,715</b> | Applicant(s)<br><b>Mach et al</b> |
|                              | Examiner<br><b>Danny Lee</b>         | Group Art Unit<br><b>1643</b>     |

Responsive to communication(s) filed on Jun 19, 1998

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claim

Claim(s) 5, 7, 8, 17, and 18 is/are pending in the application

Of the above, claim(s) 7 and 8 is/are withdrawn from consideration

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 5, 17, and 18 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Art Unit : 1643

Examiner : Danny Lee

Applicant: Mach et al

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The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1643 (formerly Art Unit 1815)**.

The Group and/or Art Unit FAX NUMBER has changed to **703-308-3014, 703-305-4242**

- 5   **as of July 7, 1997.** To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to *Group Art Unit 1643*.

Proposed correspondence for Examiner Lee should be faxed to the unofficial number  
**(703-305-7401-unofficial).**

- 10   1.   The publications listed on PTO 1449, filed 9/14/95 have not been considered, because copies were not available. Applicant is requested to provide replacement copies, which will be considered without additional petition or fee.

- 15   2.   Claims 7-8 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected Group I, the requirement having been traversed in Paper No. 6, filed 6/19/98. Claims 5, 17-18 are pending in the instant application.

The traversal is on the ground(s) that the various groups are closely related and that the search of these classes will overlap. This is not found persuasive because Applicant has provided no evidence to establish why the requirement for restriction is improper. As to the question of burden of search, classification of subject matter is merely one indication of the burdensome

nature of the search involved. The literature search, particularly relevant in this art, is not co-extensive and is much more important in evaluating the burden of search. Clearly different searches and issues are involved in the examination of each group. For these reasons the restriction requirement is deemed to be proper and is made **FINAL**.

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3. Claims 5, 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is vague in the recitation of "a fragment equivalent thereto". The term fails to define the metes and bounds of the claim. Further, it is unclear to what is encompassed by the term "fragment equivalent thereto". The recitation of "HindIII R fragment from the genome of human cytomegalovirus strain Ad169" is vague. Applicants are requested to refer to a figure or sequence to describe the "HindIII R fragment" because HindIII will cut the genome of the human cytomegalovirus into many fragments and one of skilled in the art does not know which fragment 15 is the R fragment.

35 U.S.C. 101 reads as follows:

20 Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a Patent therefor, subject to the conditions and requirements of this title.

4. Claims 17-18, 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claims 17-18, 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Nowak et al.

Nowak et al teaches a cosmid clone (pCM1058) containing the HindIII R fragment. The HindIII R fragment of strain AD169 of Nowak would inherently contain SmaI endonuclease site and codes for the pp28 gene. Since the Patent Office does not have the facilities for examining and comparing applicants' composition with the compositions of the prior art references, the burden is upon applicants to show an unobvious distinction between the material, structural and functional characteristics of the claimed composition and the compositions of the prior art.

10 6. Claims 17-18, 5 are rejected under 35 U.S.C. 102(a) as being anticipated by Meyer et al. Meyer et al teaches a nucleotide sequence containing the gene segment encoding pp28 within the HindIII R fragment of HCMV strain AD169 (abstract; figure 2). Meyer teaches that the gene is located within the SmaI restriction site (figure 2). Meyer teaches the prokaryotic expression of the pp28 gene (lambda gt11)(page 2244).

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No claims are allowed.

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Art Unit : 1643

Examiner : Danny Lee

Applicant: Mach et al

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Papers relating to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 located in Crystal Mall 1. The Fax number for Art Unit 1643 is (703) 305-3014. All Group 1600 Fax machines will be available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform  
5 with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **Danny Lee** whose telephone number is **(703) 305-7245**. The Examiner can normally be reached on Monday-Tuesday and Thursday-Friday from 6:30AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's  
10 supervisor, **Marian Knodel**, can be reached at **(703) 308-4311**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Danny Lee

August 24, 1998

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PAULA K. HUTZELL  
SUPERVISORY PATENT EXAMINER